

### **REMARKS**

Applicant has carefully reviewed and considered the Office Action mailed on August 25, 2006, and the references cited therewith.

Claims 3, 12, 20, 21, and 40 are amended. New claims 49, 50, and 51 are added to more fully describe the claimed invention, and are supported by Figures 16, 18A, 18B, and 19A and in the specification pages 58-60 and elsewhere in the application as filed. No new matter is added. Claims 3-10, 12-21, 22-25, 27-30, 31-36, 37-40, 41, 42-43, 44, 45-46, 47, 48, 49, 50, and 51 are pending. Of these, the Examiner has withdrawn the italicized claims 22-25, 31-36, 41, 44, and 47. Please charge any required fee or credit overpayment to Deposit Account 502931.

### **Arguments**

#### **Withdrawal of Claims as drawn to non-elected species**

In the Restriction Requirement mailed September 4, 2002, the Examiner requested election of one of the following species:

- I. Figs. 19A and 19B;
- II. Figs. 19C-19L.

Applicant elected species I, and added claim 40, which reads on both species, as a generic and linking claim. Applicant filed a paper January 27, 2003, identifying claims 3-21, 27-30, 37-40, and 42 as reading on the elected species. Applicant does not traverse the restriction asserting the species are different inventions if no generic linking claim is allowed. However, Applicant has previously explained that claim 40 is generic and linking, and therefore traversed the restriction regarding all claims that depend on claim 40 if claim 40 were determined to be allowable.

Claims 22-25, 31-36, 41, 44, and 47 were withdrawn by the Examiner as being drawn to a non-elected species. Applicant respectfully traverses the withdrawal of claims (but not the restriction as to species).

Claim 41, withdrawn by the Examiner, is dependent upon claim 40, which is neither

withdrawn nor restricted. Generic claim 40 reads on the withdrawn independent claims 22 and its dependent claims 23-25 and 31, and independent claim 32 and its dependent claims 33-36. Applicant traversed the non-allowance of claim 40. Accordingly, under MPEP 818.03(d), once claim 40 is held allowable, these claims should not be withdrawn, and reconsideration and allowance of the claims is respectfully requested.

Claims 44 and 47, withdrawn by the Examiner, are dependent upon claims 43 and 46, respectively, which are not withdrawn or restricted.

Further, generic claims 43 and 46 read on the withdrawn independent claims 22 and its dependent claims 23-25 and 31, and independent claim 32 and its dependent claims 33-36. Applicant traversed the non-allowance of claim 43. Accordingly, under MPEP 818.03(d), once claim 43 is held allowable, these claims should not be withdrawn, and reconsideration and allowance of the claims is respectfully requested.

### **Rejection under 35 U.S.C. § 112 Paragraph 2**

#### ***1) The Applicable Law for Rejections under 35 U.S.C. § 112 Paragraph 2***

35 U.S.C. § 112 paragraph 2 provides "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

The MPEP provides:

#### **2173.02 Clarity and Precision**

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims that define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used,

but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished) (The preamble of the Larsen claim recited only a hanger and a loop but the body of the claim positively recited a linear member. The court observed that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art. Upon review of the claim in its entirety, the court concluded that the claim at issue apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, paragraph 2.). If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. 112, second paragraph is appropriate. *In re Wiggins*, 488 F.2d 538, 179 USPQ 421 (CCPA 1973).

**2) *Arguments relative to the 35 U.S.C. § 112 Rejection of Claims 12, 20, 21, 40***

In the Non-Final Office Action mailed August 25, 2006, the Examiner repeated the assertion made in the Final Office Action mailed 6/10/2004, and again asserted that "It is not clear how moving the tray in the claimed perpendicular direction reduces the travel distance as claimed (claims 12, 20, 21, 40)." The test for clarity under § 112 is whether the claims apprise one of an ordinary level of skill in the pertinent art at the time the invention was made, of the

scope of the claim, in view of the content of the particular application disclosure, and the teachings of the prior art. It is clear from the specification and the claims, as well as from the explanations provided in each of Applicant's prior responses, that moving the trays in the claimed perpendicular direction reduces the travel distance and/or shortens the time needed to move the trays, since the stations can be placed closer to one another, and/or more trays can be placed in the path of travel, since the trays need only be moved a distance equal to their short dimension between each operation.

**When a tray immediately next to but outside an inspection station is moved into an inspection station, if the tray is oriented as claimed and moved parallel to its short dimension or perpendicular to its long dimension, the distance it travels is equal to its short dimension or its dimension perpendicular to its long dimension, respectively. Conversely, if the tray is oriented the other way and moved perpendicular to its short dimension or parallel to its long dimension, the distance it travels is equal to its dimension perpendicular to its short dimension or its long dimension, respectively. This latter distance is clearly longer than the previous distance.**

If stations are kept a fixed distance apart, there can be more trays along the path between machines, and thus the time per tray is reduced at a given tray speed. If the stations are moved closer together as allowed by the perpendicular orientation of the trays, the distance traveled by the tray is reduced, and thus the time per tray is reduced at a given tray speed.

The Examiner further states the "perpendicular to the long-dimension side" is not necessarily the same as "in the short-dimension direction" since the tray may not be rectangular; the tray could be square or have ... seven sides. Applicant does not see relevance to the Examiners hypothetical square trays for claims that recite limitations such as "the short dimension side is shorter than the long dimension side." As for trays having seven sides, Applicant's Attorney has never seen such trays, does not understand how such hypothetical trays are relevant to a 35 U.S.C. § 112 rejection, and sees no need to change the claim language. The claims do clearly recite the orientation of the tray relative to its direction of travel. Thus, one of an ordinary level of skill in the pertinent art at the time the invention was made is clearly apprised of the scope of the claim. It is respectfully requested that the rejection be reversed and

the claims allowed.

### **Rejection Under 35 U.S.C. § 103(a)**

#### ***1) The Applicable Law for Rejections under 35 U.S.C. § 103***

According to *M.P.E.P.* § 2141, which cites *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986), the following tenets of patent law must be adhered to when applying 35 U.S.C. § 103. First, the claimed invention must be considered as a whole. Second, the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination. Third, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. Fourth, obviousness is determined using a reasonable expectation of success standard. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. *M.P.E.P.* § 2141 (citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966)).

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). The references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *M.P.E.P.*

§ 2142 (citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)). In considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *M.P.E.P.* § 2144.01 (citing *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)). However, if the proposed modification would render the prior-art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *M.P.E.P.* § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

In order to take into account the inferences which one skilled in the art would reasonably make, the examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand. *M.P.E.P.* § 2141.03 (citing *Environmental Designs, Ltd. v. Union Oil Co*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984)).

The examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

*M.P.E.P.* § 2141.03.

## 2) *Arguments relative to the 35 U.S.C. § 103 Rejection of Claims*

### Claims 3-9, 12-21, 27-30, 40, 42, 43, 45, 46, and 48

Claims 3-9, 12-21, 27-30, 40, 42, 43, 45, 46, and 48 were rejected under 35 U.S.C. §

103(a) as being unpatentable over Applicant's admitted prior art [discussed on pages 2-5 of the specification] in view of Jackson et al. (US 6,139,243) Kawasaki (US 4,468,165) and Hinchcliffe et al (US 4,303,366). Applicant respectfully traverses. To show obviousness under § 103, the burden is on the Examiner to show that, considering the claimed invention as a whole and considering the references a whole, **that the references suggest the desirability** and thus the obviousness of making the combination; further, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. *Hodosh, supra*. Neither Jackson nor Applicant's discussion of the prior art provide any previous recognition of a need for, or the desirability of, moving trays parallel to their short dimension rather than parallel to the long dimension of the tray. The Examiner has repeatedly asserted that it is not clear to him how moving the trays in their short dimension reduces a distance of travel or provides a speed benefit. Accordingly, the Examiner's own assertions that the Examiner is unclear of how the claimed invention provides a benefit or shortens tray-travel distances in the §112 rejection directly contradicts his assertion of the obviousness of the claims in the §103 rejection.

In the most recent Office Action, the Examiner added Hinchcliffe et al. and Kawasaki to the previously cited Jackson patent. Hinchcliffe et al. describe and show cigarette trays with considerable height and apparently many cigarettes stacked on one another. There is no description or suggestion of an inspection station to inspect the cigarettes. While the figures in Hinchcliffe's patent apparently show a tray width about equal to the length of a cigarette (or a filter for a cigarette) and a longer length, there is no mention of the relative length and width of the trays, nor of why the trays are oriented as shown, nor any discussion of possible desirability of move the trays through an inspection station in the direction recited in the present claims. In fact, Hinchcliffe's trays (with huge numbers of stacked cigarettes or cigarette filters) are unusable in the present claimed inspection environment since the cigarettes in the middle cannot be inspected. Moreover, Hinchcliffe et al. describe a tray rotation that rotates the tray full of stacked cigarettes around a line parallel to its width, empties the tray into a different type of conveying system and then, after re-rotating the tray to back to its upright orientation, moves the empty tray down and backward (Figs 2 and 4) or at an angle to the incoming trays (Fig 6). The tray rotation operation that occurs in Hinchcliffe alters the direction of the trays as they move through the

system.

Kawasaki, on the other hand, stacks postal matter (envelopes or other mail items) in trays after inspection at a "reading station" and sorting. There is no tray rotation or flipping in Kawasaki. Kawasaki describes trays used to sort and transfer postal matter. As with Hinchcliffe et al, Kawasaki makes no mention of the relative length and width dimensions of the trays, and there is no discussion of the desirability of moving the trays in the direction recited in the present claims. Also akin to Hinchcliffe, the trays in Kawasaki have considerable height, and therefore Kawasaki cannot achieve the rotation recited in certain of the present claims without altering the advantageous spacing in the present claims. Furthermore, Kawasaki shares Hinchcliffe's problem that objects in the middle of the tray (in Kawasaki's case, postal matter) cannot be inspected, and thus the Kawasaki system could not work with the presently amended claims.

There is no description or suggestion in Hinchcliffe or Kawasaki of a smaller footprint or other benefit that would motivate one of skill in the art to combine the non-inspection tray movement of those references with the tray-flipping inspection system of Jackson et al. Further, both Hinchcliffe and Kawasaki stack the items in their trays, making it impossible to inspect all the items in the trays. In summary, there is nothing in the cited prior art that would motivate one of skill in the art at the time of the invention to combine Hinchcliffe's cigarette-tray-emptying system or Kawasaki's sorting and conveying system into that of Jackson, as proposed by the Examiner. According to MPEP 2141, "the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination." Applicant respectfully submits that the Examiner has failed to provide a motivation for combining these references, or if there is a motivation that it is impermissibly from the present application.

In contrast to the cited references, one benefit to the current claims is that the recited direction allows a tray-to-tray spacing that allows for a smaller overall footprint. There is nothing in the cited prior art that would motivate one of skill in the art at the time of the invention to combine Hinchcliffe's cigarette trays and their conveying system or the trays of stacked postal material of Kawasaki into that of Jackson, as proposed by the Examiner. Applicant respectfully asserts that the tall trays of Hinchcliffe et al and of Kawasaki would not work in the machine-vision inspection system invention of the present claims of our application



nor in the system described by Jackson. Applicant respectfully submits that the Examiner has failed to provide a motivation for combining these references, or if there is a motivation that it is impermissibly from the present application.

### **Claim 3 and its dependent claims**

It is only with the teaching of the present disclosure that this improvement is provided. Applicant's specification has provided substantial and adequate teaching to provide one of skill in the art a full and complete understanding of the advantages of the claimed invention over the prior art. The Jackson system is not capable of such advantages. The Hinchcliffe and Kawasaki patents have different trays (having stacked items in configurations that cannot be inspected) and do not provide any suggestion as to the desirability. The Jackson prior art moves the trays parallel to their long dimension, and the trays of stacked items in Hinchcliffe and Kawasaki do not suggest the proposed combination. There is no recognition that Jackson's orientation leads to longer distances in an inspection system than possible with the present invention.

The non-obviousness of the present invention is further evidenced by the Examiner's failure, in earlier Office Actions, to appreciate that moving the trays in a direction parallel to their short dimension would lessen the distance needed to move trays between stations (since the stations could be placed closer to one another) or the per-tray travel time between inspections at a given tray speed (if the stations are kept at a fixed distance apart and more trays are placed along the path between stations). See the Examiner's arguments relative to the **§ 112 Rejection** in the Office Action mailed April 15, 2003 and in the Office Action mailed June 10, 2004.

Further, the Examiner analogizes that, because the distance of travel between two cities cannot be reduced by traveling in a shorter car, Applicants cannot assert that the claimed perpendicular direction reduces the travel distance between inspection stations; this analogy is not applicable to the present application. Cities are not moved closer together because shorter cars are used in traveling between them; however, inspection stations can be placed closer together by shortening the trays moving between the stations. Further, if shorter cars were used on the highway between the Examiner's hypothetical two cities, then for any given spacing between cars (say zero feet/bumper-to-bumper for very slow traffic, or, e.g., 100 feet between the

back of one car and the front of the next car, for cars traveling 60mph) and for any given speed, more cars travel between the two cities in each hour (i.e., providing higher throughput). Unlike cities, which cannot be moved, inspection stations in a machine-vision system can be easily moved and reconfigured to take advantage of moving trays in their short dimension. Just because it is easy to do so, does not mean that it is obvious to do so. Further, Applicant's recitation of the movement relative to the short-dimension direction or the long-dimension direction clearly distinguishes the claimed invention from the cited prior art, without the need to further recite in the claims the advantages obtained by the claims as recited.

The Examiner's previous dismissal of tray orientation as a matter of design choice to one of skill in the art based on criteria such as space optimization is only possible after absorbing the teaching of the present application. Hinchcliffe and Kawasaki make no mention of the advantage of their orientation, so perhaps for them, it is merely a matter of design choice, but this does not provide a motivation to modify Jackson. Based on the Examiner's own reasoning that orientation of the trays does not affect the distance traveled, the orientation of the trays would not affect the space needed: three trays oriented with their long dimension in the direction of travel take the same area as three trays oriented with their short dimension in the direction of travel. It is only with Applicant's teaching that any such problem (such as shortening the distance of tray travel between stations, or shortening the overall length of the machine in the direction of travel) and solution is provided. There is no indication in Jackson of a desirability to move the trays along the short dimension.

Jackson moves the trays along the tray's long dimension (note Jackson Fig.1 where the axis of rotation 42 is parallel to the direction of tray travel shown by the arrow, and Fig. 4 where the axis of flip rotation 42 is parallel to the long dimension of the tray), thus increasing the time needed to transfer the trays to and from the flip station. In contrast, the present claimed invention of claims 3, 12, and 20 as amended, and their respective dependent claims recite moving the trays (to or from the flip station) in a direction perpendicular to the long-side dimension or parallel to the short-side dimension of the tray. This short-dimension movement reduces the time of travel, shrinks the footprint size of the conveyor needed, and reduces the jostling and shaking of the devices in the tray due to fast start and stop motions if the trays were moved in the long

dimension in the same amount of time (if the devices are moving when moved to the second inspection time due to jostling in the trays, extra time must be wasted to wait for the devices to stop moving so a picture can be taken). Accordingly, claims 3, 12, 17, 20 and 40 and their dependent claims appear in condition for allowance and reversal of the rejection is respectfully requested.

**Claim 9**

Claim 9 was rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses. The Examiner has failed to show any structure equivalent to the description in the present application for a means for moving the second inspection station with respect to the inverting mechanism. Reversal of the rejection is respectfully requested.

**Claim 13**

Claim 13 was rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses. The Examiner has failed to show a first tray-transfer device for holding at least the first tray, said first tray-transfer device moving the first tray from the first inspection station to the flip station; and a second tray-transfer device for holding at least the second tray, said second tray-transfer device moving the second tray from the flip station to the second inspection station. Reversal of the rejection is respectfully requested.

**Claim 14**

Claim 14 was rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses. The Examiner has failed to show a mechanism for flipping the devices carried in a tray, the mechanism further comprising means for limiting the motion of the rotator. Reversal of the rejection is respectfully requested.

**Claim 17**

Claim 17 was rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses. The Examiner has failed to show a flipping mechanism for transferring a plurality of devices from a

position in a first tray to a position in a second tray, the flipping mechanism comprising: a first jaw having a surface adapted to receive the first tray; a conveyor that moves the first tray to the first jaw in a direction substantially parallel to a shortest side dimension of the first tray; a second jaw having a surface adapted to receive the second tray; a mover for moving the first jaw, the first tray, the second tray, and the second jaw into engagement with each other, said first tray associated with the first jaw and the second tray associated with the second jaw; and a rotator for rotating the first and second jaws. Reversal of the rejection is respectfully requested.

#### **Claim 20**

Claim 20 was rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses. The Examiner has failed to show in the prior art a method for acquiring physical information associated with a plurality of devices placed in a tray, the method comprising the steps of: inspecting a first side of a device within a first tray; moving the first tray in a direction substantially perpendicular to a longer side of the first tray to reduce a distance of travel of the first tray to a flip station; moving a second tray to a position near the first tray; flipping the first tray and second tray to move the device from the first tray to the second tray and place the device in the second tray so that a second side of the device is presented in the second tray; and inspecting a second side of the device within the second tray. Reversal of the rejection is respectfully requested

#### **Claims 10, 37-39**

Claims 10 and 37-39 were rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses. To show obviousness under § 103, the burden is on the Examiner to show that, considering the claimed invention as a whole and considering the references a whole, that the references suggest the desirability and thus the obviousness of making the combination; further, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. *Hodosh, supra*. None of the cited references provide any prior-art recognition of a need for, or the desirability of, moving trays parallel to their short dimension rather than parallel to the long dimension of the tray. Accordingly, claims 37-39 and 10 appear

in condition for allowance and reversal of the rejection is respectfully requested.

#### **Claims 40, 41-42**

Regarding claim 40 and its dependent claims 41-42, the cited references do not show a tray-transfer device combined with the other elements that moves the devices from the first inspection station to the second inspection station in a direction substantially perpendicular to the long-dimension side of the tray. Accordingly, claims 37-39 and 10 appear in condition for allowance and reversal of the rejection is respectfully requested.

Further, claim 40 provides a generic linking claim between independent claims 3, 12, 17, 20, 37 and independent claims 22 and 32, and dependent claim 41. Thus, claim 3 (and its dependent claims 4, 5, 6, 7, 8, 9, 10, and 27), 12 (and its dependent claims 13, 14, 15, 16 and 28), 17 (and its dependent claims 18, 19 and 29), and 20 (and its dependent claims 21 and 30); and independent claims 22 (and its dependent claims 23, 24, 25 and 31) and 32 (and its dependent claims 33, 34, 36) are linked by a generic claim 40.

#### **Claims 43, 44-45**

Regarding claim 43 and its dependent claims 44-45 and claim 46 and its dependent claims 47-48, the cited references do not show the equivalent structure for the means for inverting as recited (and combined with the other elements) and for moving the devices from the first inspection station to the second inspection station in a direction substantially perpendicular to the long-dimension side of the tray. Claim 43 is a means-plus-function claim that must be examined under 35 U.S.C. § 112 paragraph 6 to cover the corresponding structure, materials or acts described in the specification and equivalents thereof. The Examiner has failed to provide any showing of structure or acts equivalent to those described in the present specification to provide the recited means. Accordingly, Applicant respectfully requests that the rejection be reversed and that these claims be allowed.

#### **Claims 46, 47-48**

Regarding claim 46 and its dependent claims 47-48, the cited references do not show the

equivalent structure for the means for inverting as recited (and combined with the other elements) and for moving the devices from the first inspection station to the second inspection station in a direction not parallel to the long dimension side of the tray. Claim 46 is a means-plus-function claim that must be examined under 35 U.S.C. § 112 paragraph 6 to cover the corresponding structure, materials or acts described in the specification and equivalents thereof. The Examiner has failed to provide any showing of structure or acts equivalent to those described in the present specification to provide the recited means. Accordingly, Applicant respectfully requests that the rejection be reversed and that these claims be allowed.

Further, claims 43 and 46 each provide a generic linking claim between independent claims 3, 12, 17, 20, 37 and independent claims 22 and 32, and dependent claims 41, 44, 45, 47, and 48. Thus, claim 3 (and its dependent claims 4, 5, 6, 7, 8, 9, 10, and 27), 12 (and its dependent claims 13, 14, 15, 16 and 28), 17 (and its dependent claims 18, 19 and 29), and 20 (and its dependent claims 21 and 30); and independent claims 22 (and its dependent claims 23, 24, 25 and 31) and 32 (and its dependent claims 33, 34, 36) and dependent claims 44, 45, 47, and 48 are linked by generic claims 43 and 46. Since the generic linking claims appear allowable as described above, reversal of the rejection and allowance of the claims are respectfully requested.

**Claims 22, 44, 47 (all of which stand withdrawn)**

With regard to the rejection of claims 22, 44, and 47, Applicant respectfully traverses any rejection. Jackson only discusses flipping the devices from a first tray into a second tray and then passing the second tray. In such a system, any identification or markings on the first tray that are associated with a particular set or batch of devices are no longer associated with the devices once they are placed in the second tray. Neither Jackson nor the Applicant's discussion of the prior art flips the devices and then puts the devices back into the same tray. In contrast, the present Figures 19c-19g show flipping a plurality of devices and then placing them back into the same tray.

Accordingly, the claims appear to be in condition for allowance, and reconsideration and reversal of the rejections is respectfully requested.

**New claims**

New claims 49-51 are added to more fully describe the claimed invention. Consideration and allowance of these claims is respectfully requested.

**Conclusion**

It is respectfully submitted that the claimed invention is patentable in view of the cited art. It is respectfully submitted that claims 3-10, 12-21, 27-30, and 37-51 should therefore be allowed. Reconsideration and withdrawal of the Examiner's rejections of claims 3-10, 12-21, 27-30, and 37-48 is respectfully requested.

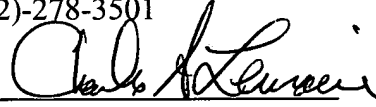
Respectfully submitted,

Arye Malek et al.  
By their representatives,

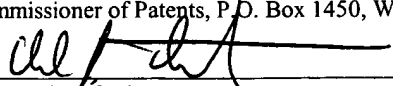
Lemaire Patent Law Firm, P.L.L.C.  
P.O. Box 11358  
St. Paul, MN 55111

Customer Number 40064  
(952)-278-3501

Date: 27 November 2006

By:   
Charles A. Lemaire  
Reg. No. 36,198

CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8: I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Washington, D.C. 22313-1450, on the 27<sup>th</sup> day of November, 2006.

  
Dale J. Thomforde